Remarks

CURRENT STATUS

For a Non-Final Office Action, dated May 1, 2006, Claims 1-75 were pending though Claims 26-48 and 72-75 have been withdrawn. The Examiner has rejected Claims 1-25 and 49-71.

CLAIM OBJECTIONS

In response to the Examiner's Objections to the Claims for informality, the Applicants have amended:

Claim 1, to delete "the" in line 1;

Claim 5, to change "Claim 5" to "Claim 4;"

Claims 6-26, to change "claim 6" to "claim 5;"

Claims 7 and 53, to recite "LINUX" rather than "LINIX;"

Claim 20, to add a period at the end of the claim;

Claims 24 and 70, to capitalize "internet;" and

Claim 49, to recite "connected to the server", rather than "connected to the computer."

CLAIM REJECTIONS — 35 USC § 112

While the Examiner has rejected Claims 12 and 58, in light of the limitation "PARTRAN," the Applicants submit that PARTRAN or "Parallel Reactive Transport Model" was know to those skilled in the art at the time of the application. Attached hereto as Exhibit 1, is a peer-reviewed journal article by the authors, Glenn E. Hammond, Albert J. Valocchi, and Peter C. Lichtner describing the model. The "test for sufficiency of support in a parent application is whether the disclosure of the application relied upon reasonably conveys to the artisan that the inventor had possession [of the later claimed subject matter] at that time ...." *Ralston Purina Co.*

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v. Far-Mar-Co., 772 F.2d 1570, 1575 (Fed. Cir. 1985). 1111, 1117 (Fed. Cir. 1991). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

The claims as filed in the original specification are part of the disclosure and therefore, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification (35 U.S.C. § 112, second paragraph), the applicant may rely upon the claim itself to disclose the claimed subject matter. *In re Benno,* 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985). MPEP 2163.06. The Applicants request that the Examiner take Official Notice that interaction with the PARTRAN operating model residing on a server was known to those skilled in the art at the time of the application. Thus, the mention on PARTRAN is itself support for the claimed limitation in Claims 12 and 58. In the alternative, the Applicants request leave of the Examiner to amend the specification to include specific mention of PARTRAN.

The Examiner also rejected Claims 16 and 62 on a similar basis for the inclusion of the limitation "ADEPT." Applicant has cancelled Claims 16 and 62.

The Examiner also rejected Claims 3, 6-11, 15, 51-57 and 61 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

To quote MPEP section 2173.05(u) Trademarks or Trade Names in a Claim:

"The presence of a trademark or trade name in a claim is not, *per se*, improper under 35 U.S.C. 112, second paragraph, but the claim should be carefully analyzed to determine how the mark or name is used in the claim. It is important to recognize that a trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus a trademark or trade name does not identify or describe the goods associated with the trademark or trade name." On the other hand, each of JAVA, LINUX, UNIX, DOS, and CATIA are the sole means of

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referencing operating systems that are each analogous to the names of various metals in a mechanical patent or doped silicons in semiconductor fabrications. While the ambiguity of using a trademark attaches to the use of TEFLON™ instead of PTFE or polytetrafluoroethylene, it does not similarly attach to JAVA, for example.

The Microsoft Computer Dictionary, Fifth Edition, 2002 has individual definitions for each of the terms: JAVA (p. 293), LINUX (p. 313), and UNIX (p. 540) MACINTOSH (p. 323). As an exemplary definition, the Java entry is useful:

"Java *n.* An object-oriented programming language developed by Sun Microsystems, Inc. Similar to C++, Java is smaller, more portable, and easier to use than C++ because it is more robust and it manages memory on its own. Java was also designed to be secure and platform-neutral (meaning that it can be run on any platform) through the fact that Java programs are compiled into bytecode, which is not refined to the point of relying on platform-specific instructions and runs on a computer in a special software environment known as a virtual machine. This characteristic of Java makes it a useful language for programming Web applications, since users access the Web from many types of computers. Java is used in programming small applications, or applets, for the World Wide Web, as well as in creating distributed network applications. See also bytecode, Java applet, Jini, object-oriented programming."

DOS is not a trademarked product but merely an acronym for "Disk Operating System." "CATIA™" and "AutoCAD™" are both trademarked products but similarly to the terms, it is the position of the Applicants that they are also the only means to refer the interchange of data with either of Catia™ or AutoCAD™ programs. The Examiner's attention is respectfully invited to Page 9 of the Application and the description of wrapping software. The invention facilitates wrapping of these specific products. There is no more precise manner to describe the language necessary. The Applicants believe that reliance upon the trademarked terms is neither ambiguous

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nor indefinite under the second paragraph of 35 USC § 112. Claims 11, 15, 57, and 61 have been amended to include the ™ symbol.

CLAIM REJECTIONS - 35 USC § 101

Applicant has amended Claims 1-25 which the Examiner has rejected under 35 U.S.C. 101 to include the limitation of "computer instructions residing on computer-readable media" rather than to a "software product".

CLAIM REJECTIONS - 35 USC § 102

The Examiner rejected Claims 1-5, 13-14, 17, 19-25, 49-51, 59-60, 63 and 65-71 under 35 U.S.C. 102(e) as being anticipated by Myers, Jr. et al., U.S. Patent No. 6,961,687.

In comparing the teaching of Myers, Jr. et al. to the instant claims 1 and 49, the Examiner asserts "[i]f the Graphic User Interface 70 is the two-way communications portal between the system and the individual user, there must be 'a translation means between the uniform language of the graphic user interface 70 that will interpret the signals the interface generates into requests for the legacy programs as objects,' it would appear the system of Myers et al. inherently possesses this feature since a two-way portal, between a system and an individual is utilized, and therefore there must exist a translation means so as to convert from the language of client into a language used by the system." The assertion by the Examiner is one of Official Notice and ignores the explicit definition set forth for the associative information model of Myers, Jr. et al.:

> Engineering has traditionally been a document-centric activity. Drawings, bills of material, specifications, software and system designs, test plans, training manuals, user manuals, etc. convey the information between the various communities and domains. By placing product information at the center of the system life cycle, tightly coupled multi-disciplinary and enterprise member interactions are facilitated. This associative information model of the product is referred to as the "Product Model."
>
> An *associative information model* (Product Model) is defined for the enterprise. This product model is the basis for a database schema to include *all data defined*

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> *for use in implemented domains and tools in the CEE.* It may include additional data, as desired. *System physical descriptions, system functional descriptions, system operational descriptions, system environment descriptions and system schedules are defined in the Product Model.* Thus, the Product Model *contains a complete specification of the system.* While the preferred embodiment is to implement all domains in an enterprise as members of the CEE, domains may be incrementally added to the CEE as time and funds permit. A CEE comprising only a subset of all domains in the enterprise is an advantage over limited systems of the prior art which provided minimal cross-domain collaboration. As a minimum, the Product Model need only contain the essential "independent" data for implemented domains. "Dependent" data may be generated on an as-needed basis using the independent data contained in the database.
>
> Column 4, Lines 38-64.

The associative information model is taught as containing all information within the system, in contrast the independent claims 1 and 49 use a look-up table to translate between a uniform language data and the legacy data necessary to communicate with any one of the servers. Because of the assumption of equivalence between the Myers, Jr. et al. associative information model and the instant look-up table, the Examiner has employed "Official Notice" to find that all of the elements of instant application are present.

Official Notice was defined in the Court of Claims and Patent Appeals case, *In re Ahlert,* 424 F.2d 1088, 1091-1092 (C.C.P.A. 1970) where the Court recognized that the Patent Office "may take notice of facts beyond the record which, while not generally notorious, are capable of such instant and unquestionable demonstration as to defy dispute." Such a power is narrowly construed by the courts and the federal courts are charged to "regard facts found in such manner with an eye toward narrowing the scope of any conclusions to be drawn therefrom. Assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference." Further, "[a]llegations concerning specific 'knowledge' of the prior art,

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which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge."

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California,* 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 Fed. Cir. 1987). The MPEP states at § 2131.02: "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

The Examiner has reasoned that because the result of having a two-way portal is communication between the graphical user interface and the Examiner is using *a priori* reasoning; the Examiner has decided that because the same result occurs, it must be done in the same fashion. This is impermissible reasoning. By its own explicit admission, an admission carried through in the appeal brief, the inventive entity for the Myers, Jr. et al. patent, requires all knowledge to reside in the associative model. The instant application, rather, leaves the knowledge on the individual servers and merely translates the queries.

Every element of the claimed invention must be literally present, arranged as in the claim. *Perkin-Elmer Corp.,* 732 F.2d at 894, 221 USPQ at 673; *Kalman v. Kimberly-Clark Corp.,* 713 F.2d 760, 771-72, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026, 79 L. Ed. 2d 687, 104 S. Ct. 1284 (1984). The identical invention must be shown in as complete detail as is contained in the patent claim. *Jamesbury Corp., 756 F.2d at 1560,* 225 USPQ at 256; Connell, 722 F.2d at 1548, 220 USPQ at 198. The details have not been shown to be present here. What is at least necessary is an affidavit of the Examiner. When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons. See 37 CFR 1.104(d)(2). The factual grounds for rejection, here, are inadequate.

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CLAIM REJECTIONS - 35 USC § 103

With the involved facts determined, the Examiner confronts a ghost, i.e., "a person having ordinary skill in the art," not unlike the "reasonable man" and other ghosts in the law. To reach a proper conclusion under § 103, the Examiner must step backward in time and into the shoes worn by that "person" when the invention was unknown and just before it was made. In light of all the evidence, the Examiner must then determine whether the claimed invention as a whole would have been obvious at that time to that person. 35 U.S.C. § 103. *Panduit Corp. v. Dennison Mfg. Co.,* 810 F.2d 1561, 1566 (Fed. Cir. 1987)

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C.S. § 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher. *In re Kotzab,* 217 F.3d 1365 (Fed. Cir. 2000).

Among legal standards for determining scope and content of the prior art, for example, are: a prior patent must be considered in its entirety, i.e., as a whole, including portions that would lead away from the invention in suit, *W.L. Gore & Associates, Inc. v. Garlock, Inc.,* 721 F.2d 1540, 1550, 220 U.S.P.Q. (BNA) 303, 311 (Fed. Cir. 1983), *cert. denied,* 469 U.S. 851, 83 L. Ed. 2d 107, 105 S. Ct. 172 (1984); elements of separate prior patents cannot be combined when there is no suggestion of such combination anywhere in those patents, *ACS Hospital Systems, Inc. v. Montefiore Hospital,* 732 F.2d 1572, 1577, 221 U.S.P.Q. (BNA) 929, 933 (Fed. Cir. 1984); and an Examiner should avoid hindsight, *W.L. Gore & Associates, Inc.,* 721 F.2d *at* 1553, 220 USPQ *at* 313.

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A determination that an invention would have been obvious when it was made to one of ordinary skill in the art under §103. The "degree to which" it is one of fact is solely that degree required to erect a foundation of facts capable of supporting the conclusion, those facts having been found by applying correct legal standards and expressed in findings free from clear error and based on clear and convincing evidence. A determination that an invention would not have been obvious when it was made to one of ordinary skill in the art is also a conclusion of law.

The Examiner rejects Claims 18 and 64 under 35 U.S.C. 103(a) as being unpatentable over Myers Jr. et al., as applied to claim 1 above, and further in view of Official Notice. To do so, the Examiner again takes Official Notice this time with respect to email as it is a feature notoriously well known in the art of communications between computers and its incorporation would have been obvious to one of ordinary skill in the art in order to provide a simple way of communicating with the remote computer. The same objections to this application of Official Notice are interposed as above. Regardless of how well-known the feature of email is, there is nothing that indicates that email notice was incorporated in such a management system, nor is the motive for doing so taught in the Myers, Jr. et al. reference. Along with the above-mentioned infirmities in the congruence of an associative information model and the look-up table asserted in the instant invention, the assertion of obviousness must fail.

Still a third time, the Examiner has relied upon Official Notice to be taken with respect to servers running the software environments defined as UNIX, LINUX, Windows, DOS, Macintosh OS, CATIA, and AutoCAD as they are programs that were all well known at the time the invention was made, and because of that, the Examiner then makes the jump that "their incorporation would have been obvious since they all represent well known programs for operating a service such as a server or a program utilized by the server for providing resource management functions, and this would have been obvious to one of ordinary skill in the art at the time the invention was made since this is precisely what Myers Jr. et al. aims to achieve, that is, managing resources in a manufacturing environment." An affidavit is necessary to assert both of

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the presence of the elements and *the further motivation to combine them.* If the Examiner is relying upon some specialized knowledge not present on the face of the Myers, Jr. et al. patent, then he must provide the affidavit containing that specialized knowledge.

The Examiner also asserts Hoskins et al., U.S Patent No. 6,108,662 against Claims 11 and 57 and 15 and 61 respectively. Hoskins teaches away from the instant invention in that Hoskins teaches a unified database much as Myers, Jr. et al., to wit:

> An Enterprise Control Database (ECDB) acts as a single repository of enterprise information containing instantaneous access to engineering bill-of-material (EBOM) data for parts and assembly of parts as well as maintaining manufacturing bill-of-material (MBOM) which tracks the finished goods inventory as it is built. Factory service records are also captured and stored in the database as they occur. Control assemblies and control components are also stored in the ECDB. Diagnostic assemblies and diagnostic components are also stored with the control system configuration (processor, racks, networks and wiring diagrams).

The same infirmities as Myers Jr. et al. prevent Hoskins from being an effective reference for obviousness.

CONCLUSION

The Applicants thank the Examiner for a thoughtful and thorough examination of the claims. The Applicants are grateful for the Examiner's insights. In the event that any of the claims as amended or the arguments set forth herein raise any questions, the Applicants request that the Examiner contact the Applicant's attorney of record, the undersigned.

Respectfully submitted,

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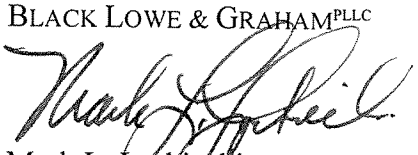

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